

SN-US045038

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Attn: Mail Stop AF
Kazuhiro FUJII	:	Patent Art Unit: 3682
Serial No. 10/826,272	:	Examiner: Vinh Luong
Filed: April 19, 2004	:	Confirmation No. 9912
For: ELECTRICAL BICYCLE SHIFT CONTROL	:	
DEVICE	:	

PETITION UNDER 37 CFR § 1.181

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In response to the November 15, 2007 final Office Action, Applicant hereby petitions for withdrawal of the objection to the August 2, 2007 Amendment for allegedly introducing new matter in the disclosure (drawings and specification), as set forth in the November 15, 2007 final Office Action. Applicant also submits a petition fee of \$130.00 to cover this petition. Applicant believes the changes to the drawings and specification made in the August 2, 2007 Amendment are clearly supported by the original disclosure¹, and thus, do not introduce new matter into the instant application, as explained below.

A. Background

1. The above-identified application including claims 1-36 was filed with the U.S. Patent and Trademark Office on April 19, 2004.
2. On February 6, 2006, a Preliminary Amendment was filed with the U.S. Patent and Trademark Office.
3. On December 21, 2006, Restriction Requirement was mailed by the U.S. Patent and Trademark Office. Patentably distinct species I (illustrated in Figures 1-16), species II (illustrated in Figures 17-18), species III (illustrated in Figures 19-21), and species IV (illustrated in Figures 22-24) were identified in the Restriction Requirement.

¹ The original drawings (note Figures 3-7 in particular) clearly support these changes, as explained below.

4. On January 10, 2007, an Amendment and Response to Restriction Requirement was filed with the U.S. Patent and Trademark Office. Applicant elected Species I (illustrated in Figures 1-16) for examination on the merits, and indicated that claims 1-31 read on the elected species I (illustrated in Figures 1-16). Claims 32-36 were cancelled.

5. On April 18, 2007, a first Office Action on the merits was mailed by the U.S. Patent and Trademark Office. In the April 18, 2007 Office Action, claims 1-31 were rejected in view of prior art. Claims 1-10 were also rejected as being indefinite. The disclosure (drawings and specification) was also objected to.

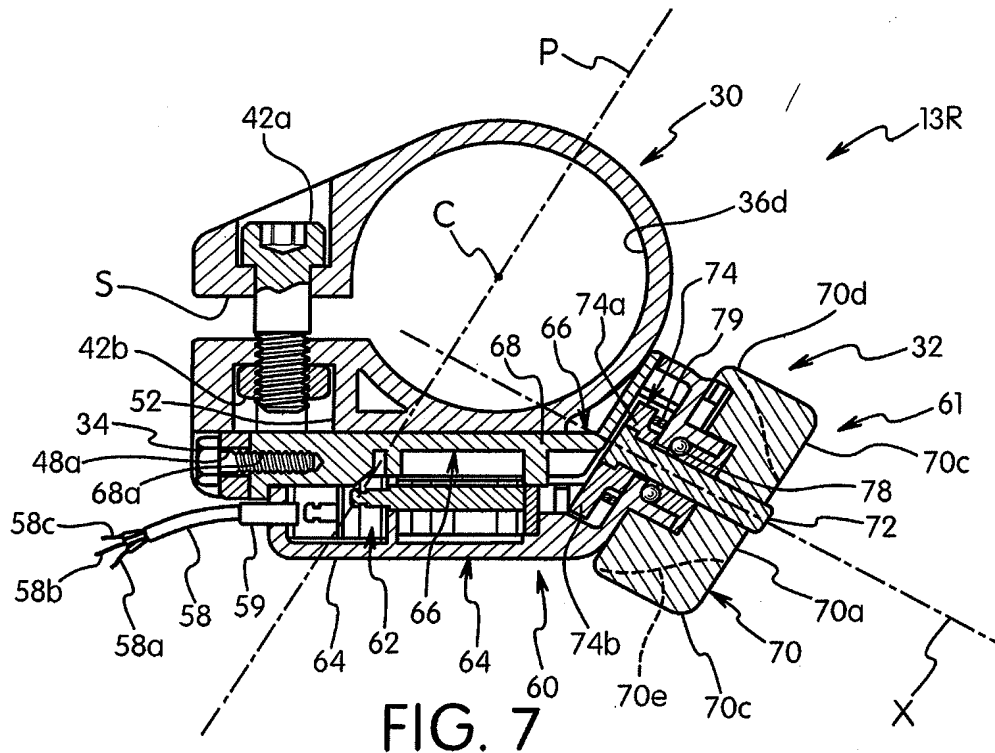
6. On August 2, 2007, Applicant filed an Amendment in response to the April 18, 2007 Office Action with the U.S. Patent and Trademark Office. In the August 2, 2007 Amendment, Applicant amended the drawings, the specification and claims 1, 2, 6, 11, 12, 14, 15, 17-19, 22, 26 and 28. Applicant amended the disclosure (drawings and specification) to (1) to illustrate a plane P and provide reference numerals for features set forth in amended claim 22, and (2) to provide proper antecedent basis for the new terminology set forth in amended claim 22. Contrary to the assertions of the Office Action, these changes to the disclosure (drawings and specification) do not introduce new matter into the instant application.

7. On November 15, 2007, a final Office Action was mailed by the U.S. Patent and Trademark Office in response to the August 2, 2007 Amendment. In this final Office Action, claims 11-17 were rejected in view of prior art while claims 19-21 were allowed and claims 1-10 were indicated as containing allowable subject matter. The November 15, 2007 Office Action asserted that Applicants' August 2, 2007 Amendment introduced new matter into the disclosure (drawings and specification). Applicant disagrees.

Applicant hereby petitions for withdrawal of the objections to the August 2, 2007 Amendment for allegedly introducing new matter in the disclosure (drawings and specification), as set forth in the November 15, 2007 final Office Action, as explained below.

B. Drawings

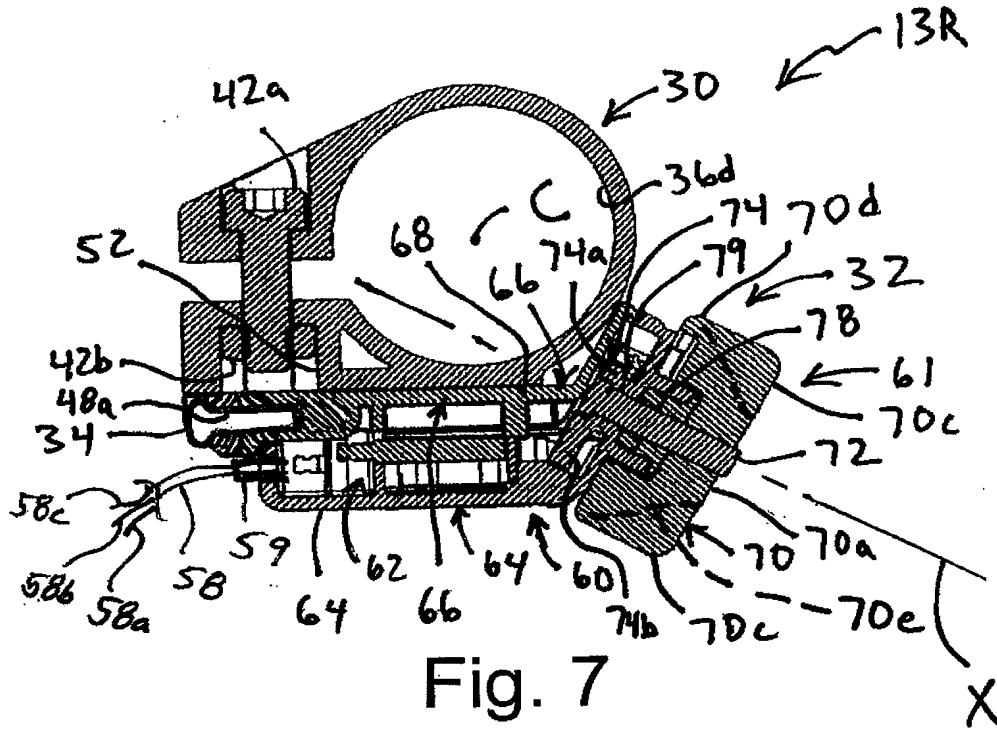
In the August 2, 2007 Amendment, Applicant added the plane P that is perpendicular to the rotation axis X and passes through the center axis C to Figure 7. Also, the reference character "S" identifying the split was added to Figure 7. See the reproduction of Figure 7 from the August 2, 2007 Amendment below.



Adding this plane P that is perpendicular to the rotation axis X and passes through the center axis C to Figure 7 does not constitute an introduction of new matter. Rather, such a plane was inherently present in original Figure 7, but was merely not yet explicitly identified. In other words, a plane that is perpendicular to the rotation axis X and passes through the center axis C is inherently present in original Figure 7, and thus, is merely being clearly, explicitly identified as plane "P" by the August 2, 2007 Amendment. This change to Figure 7 was made in view of the changes to claim 22 (i.e., the plane and split are set forth in amended claim 22) and in view of an objection in the April 18, 2007 Office Action that "a mating mounting structure" set forth in the claims was not identified with a reference numeral. In other words, based on this prior objection, Applicant believed that the plane P and the split S should be clearly identified in the drawings to avoid a potential objection from the Examiner.

C. Specification

In the August 2, 2007 Amendment, Applicant amended paragraph [0049] to state “tubular clamping member 36 includes a first attachment end 36a, a second attachment end 36b and a band section 36c extending between the attachment ends 36a and 36b to form a split S between the first and second attachment ends 36a and 36b, as seen in Figure 7.” Also, Applicant amended paragraph [0064] to state “The pivot axis X preferably intersects the curved mounting surface 36d of the tubular clamping portion 36 such that the operating member 61 is disposed on an opposite side of a plane P from the split S. The plane P is perpendicular to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14, as best seen in Figure 7.” Adding this language to the specification does not constitute an introduction of new matter. Specifically, such language is clearly supported by the original drawings (e.g., original Figures 3-6) and the original specification, which form parts of the original disclosure. See original Figure 7, which is reproduced below.



It is clear from this Figure that *the operating member 61 is disposed on an opposite side of a plane (the plane being perpendicular to the operating axis X and passing through the center axis C of the transverse portion T of the handlebar 14) from the split of the portion 30*. In fact, it is clear from this Figure alone that the operating member and the split lie on opposite sides of

many different planes, the plane P merely being one that is easily identifiable because of its arrangement relative to the operating axis X and the center axis C of the transverse portion T of the handlebar 14.

B. Conclusion

Based on the above, Applicant hereby petitions for withdrawal of the objections to the August 2, 2007 Amendment for allegedly introducing new matter in the disclosure (drawings and specification), as set forth in the November 15, 2007 final Office Action.

Respectfully submitted,

/Patrick A. Hilsmier/
Patrick A. Hilsmier
Reg. No. 46,034

GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444
Dated: January 15, 2008

S:\01-JAN08-YTY\SN-US045038 Petition.doc